

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent application of:

Applicant(s): Fred Landram et al.

Serial No: 10/688,316

Filing Date: October 17, 2003

Title: SELF CONFIGURING MOBILE DEVICE AND SYSTEM

Examiner: Djenane M. Bayard

Art Unit: 2141

Docket No. TELNP0200US

PETITION TO THE DIRECTOR UNDER 37 CFR §1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Request is hereby made for review of the Examiner's refusal to enter and consider a declaration under 37 CFR §1.181. In refusing to enter and consider the declaration, the Examiner did not follow procedures as set forth in the MPEP and discussed in more detail below.

In the event any fee is due in connection with the filing of this paper, the Commissioner is authorized to charge those fees to our Deposit Account No. 18-0988 (under the above Docket Number). In the event an extension of time is needed to make the filing of this paper timely and no separate petition is attached, please consider this a petition for the requisite extension and charge the fee to our Deposit Account No. 18-0988 (under the above Docket Number).

Remarks

Statement of Facts

The claims of the present application stand rejected under 35 USC §103(a) as being unpatentable over *Nixon et al.* (U.S. Pat. Pub. 2004/0259533) in view of *Findikli* (U.S. 6,529,727), *Rosenberg* (U.S. 6,628,934) and/or *Natsumo* (U.S. Pat. Pub. 2005/0148367). *Nixon et al.* is the primary reference in all claim rejections.

A declaration under 37 CFR §1.131 was filed on September 11, 2007 that established a date of invention at least as early as June 17, 2003, which is prior to the filing date of *Nixon et al.* (filing date of June 18, 2003). Accordingly, *Nixon et al.* does not qualify as prior art for the instant claim rejections.

On October 2, 2007, the Examiner issued an Advisory Action stating that the declaration raises new issues that require further consideration. As a result, the claims of the instant application remained finally rejected. No further comment was provided by the Examiner.

Subsequent to the mailing of the Advisory Action, a telephone call was made to the Examiner to request reconsideration of the declaration (a written request for reconsideration is also being submitted herewith). In particular, it was pointed out that §716.01 of the MPEP (see below) supports entry of the declaration. The Examiner indicated that since the outstanding Office Action had been made final, consideration of the declaration was not required.

For at least the reasons provided below, it is believed that the declaration filed on September 11, 2007 should have been considered by the Examiner.

The Declaration Was Timely Filed

Section 716.01 of the MPEP provides the generally applicable criteria for evidence traversing rejections. In particular, §716.0(A) states

A) Timeliness. Evidence traversing rejections must be timely or seasonably filed to be entered and entitled to consideration. *In re Rothermel*, 276 F.2d 393, 125 USPQ 328 (CCPA 1960). Affidavits and declarations submitted under 37 CFR 1.132 and other evidence traversing rejections are considered timely if submitted:

* * *

(3) after final rejection **>, but before or on the same date of filing an appeal, upon a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented in compliance with 37 CFR 1.116(e); or

* * *

In the instant case, the Declaration was submitted after a final rejection and before filing an appeal and, thus, 716.01(A)(3) is applicable. Thus, in order to be considered timely, a showing of good and sufficient reasons why the declaration was necessary and was not earlier presented must be provided.

In the reply to the final Office Action (mailed September 11, 2007), such reason was provided. In particular, the following comments were submitted.

The enclosed Declaration was not previously submitted because, in applicant's opinion, the claims of the present application were distinguishable from the art cited in the first Office Action dated December 22, 2005. In response to the Examiner's rejections as set forth in the first Office Action, applicant presented well-reasoned arguments on the merits distinguishing the claims of the present application from the cited art. Due to these well reasoned arguments based squarely on the merits, the Declaration was not believed to be necessary.

In response to applicant's arguments as set forth in the reply to the first Office Action, the Examiner maintained all rejections and made the Action final. While applicant disagrees with the Examiner's rejections, in the interest of advancing prosecution, applicants now are submitting the Declaration establishing a date of invention prior to the *Nixon* reference. This Declaration is necessary because the Examiner maintained all claim rejections despite applicant's arguments clearly distinguishing the claims from the cited art.

In the Advisory Action mailed October, 2007, the Examiner did not provide any specific response to the above comments.

In view of the above, it is respectfully submitted that the Declaration was timely submitted.

Consideration of Evidence

Section 716.01(B) of the MPEP states that

Evidence traversing rejections, when timely presented, ***must be considered*** by the examiner whenever present.... ***Where an examiner holds that the evidence is sufficient to overcome a prima facie case, the comments should be consistent with the guidelines for statements of reasons for allowance*** (emphasis added).

As noted above, the Declaration was believed to be timely filed. Thus, and in accordance with §716.01(B), the declaration must be considered.

In view of the above, it is respectfully submitted that the Examiner's failure to consider the declaration is in error, and request is hereby made to have the declaration considered.

Conclusion

In view of the foregoing, request is made for timely notice of consideration of the declaration.

Respectfully submitted,

RENNER, OTTO, BOISSELLE & SKLAR, LLP

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